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In re Application of	:	DECISION ON
KLOTZER	:	
Application No.: 10/058,443	:	PETITION
Filing Date: January 22, 2002	:	
Attorney's Docket No.: DES:3568.0076	:	UNDER 37 CFR 1.137(b)
For: EXPANDED POROUS THERMOPLASTIC	:	
POLYMER MEMBRANES AND DEVICE FOR	:	
THE PRODUCTION THEREOF	:	

This is in response to the petition under 37 CFR 1.137(b), filed September 22, 2003, to revive the above-identified application.

#### BACKGROUND

On 19 January 1999, applicant filed international application PCT/EP99/00286, which claimed priority of an earlier German application filed 29 January 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 29 July 2000.

On 18 August 2000, applicant filed an application under 35 U.S.C. 111(a). the application was assigned U.S. application number 09/642,390. On 11 June 2001, the first sentence of the description was amend to read as follows: "Pursuant to 35 USC §§ 365(b) and 119, the priority of PCT/EP99/00286 filed 19 January 1999 and German application DE 198 03 362.1 filed 29 January 1998 is claimed."

On 22 January 2002, applicant filed divisional application 10/058,443. A preliminary amendment was filed on the same date amending the first line of the specification as follows:

"This is a divisional of Application Serial No. 09/642,390 filed August 18, 2000. The priority of PCT/EP99/00286 filed January 19, 1999 and DE 198 03 362.1 filed January 29, 1998 is claimed pursuant to USC 35 §§120 and 365(b), respectively."

On 22 September 2003, applicant filed the present petition under 37 CFR 1.137(b) to revive the PCT application.

### DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the applicant became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable was unintentional, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) by a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995. The petition fee required by law is \$1300. If applicant can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated. See 37 CFR 1.27.).

Applicant's petition satisfies items (1), (3) and (4). The petition fails to satisfied the requirement for a proper response because US application 09/642,390 does not claim benefit under 35 U.S.C. 120 to the PCT application. While a continuing application may be the proper response, in this instance applicant has not made and perfected a claim under 35 U.S.C. 120 to the international application. Applicant may overcome this deficiency by filing a petition and \$130.00 petition fee under 35 U.S.C. 182 in application 09/642,390 to amend the first sentence to state "This application is a continuation of PCT/EP99/00286 filed January 19, 1999." The specific reference may also be made in an application data sheet.

### Benefit claim in 10/058,443

The benefit claim in 10/058,443 is not sufficient because for a proper claim to be made, 35 U.S.C. 120 requires the relationship of the application to be set forth in the first line of the specification. Furthermore 37 CFR 1.78(a)(2) states in part:

"i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the

applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (A) An application for a design patent;
- (B) An application filed under 35 U.S.C. 111 (a) before November 29, 2000; or
- (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title.

(iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
- (ii) The surcharge set forth in § 1.17(t); and (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional."

While applicant has properly made the reference to parent application 09/642,390, applicant has failed to make the specific reference to the PCT application in this application. Therefore if applicant wishes to claim benefit of this PCT application in application 10/058,443, applicant must file a petition and petition fee of \$1330.00 in 10/058, 443 under 37 CFR 1.78(a)(3) and amend the specification as follows. "This application is a divisional of Application Serial No. 09/642,390 filed August 18, 2000, which is a continuation of PCT/EP99/00286 filed January 19, 1999." The specific reference may also be made in an application data sheet. Applicant is also reminded that, if an amendment to the specification, or an application data sheet (ADS), is submitted in an application under final rejection, the amendment or ADS must be in compliance with 37 CFR 1.116. The amendment or ADS filed in an application under final rejection will not be entered as a matter of right. See MPEP 714.12 and 714.13. Therefore, applicant should consider filing a request for continued examination (RCE) (including fee and submission) under 37 CFR 1.114 with the petition to accept an unintentionally delayed benefit claim, the surcharge, and an amendment that adds the proper reference to the first sentence of the specification or an ADS.

A copy of this decision will be placed in 09/642,390

### CONCLUSION


The petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required for the filing of a renewed petition under 37 CFR 1.137(b). Extensions of time may be obtained under 37 CFR 1.136(a).

Applicant should file a petition and fee in application number 09/642,390 under 37 CFR 1.182 to make a claim under 35 U.S.C. 120 to the international application and a renewed petition under 37 CFR 1.137(b) to revive the international application for copendency with application 09/642,390.

Applicant should file a petition and \$1330.00 petition fee in application number 10/058,443 under 37 CFR 1.78(a)(3) to make a claim under 35 U.S.C. 120 to the international application.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



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